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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Metso Minerals (Cappagh) Ltd.

Serial No. 76400174

Leslie Meyer-Leon of IP Legal Strategies Group P.C. for
Metso Minerals (Cappagh) Ltd.

Julie A. Watson, Trademark Examining Attorney, Law Office
104 (Chris Doninger, Managing Attorney).

Before Walters, Grendel and Rogers, Administrative
Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

INTRODUCTION AND BACKGROUND

At issue in this ex parte appeal are the Trademark
Examining Attorney's final refusal to register applicant's
mark SMARTSCREEN on the ground of mere descriptiveness
under Trademark Act Section 2(e)(1), and her final
requirement for an acceptable identification of goods.
Specifically with respect to the identification of goods

issue, the Trademark Examining Attorney contends that the original identification of goods in the application is unacceptable as indefinite, and that applicant's proposed amendments to the identification of goods are beyond the scope of the original identification of goods.

The appeal is fully briefed. Applicant requested an oral hearing but then withdrew the request, and no oral hearing was held. The facts are as follows.

On April 25, 2002, applicant filed an application to register the mark SMARTSCREEN (in standard character form) for goods identified in the original application as "components for monitor and control of material screening and separating apparatus" in International Class 7.¹

¹ Serial No. 76400174. The application was based on Section 44, 15 U.S.C. §1126. Applicant has registered the mark in Great Britain, Registration No. 2292768, and claims a Section 44 priority date of February 15, 2002. The goods identified in the Great Britain registration are as follows:

Class 07 - crushing and material filtering machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; components for monitoring and controlling material filtering and separating apparatus; control apparatus and installations for engines, industrial machines, machine tools and motors; conveyors; conveyors for controlling the movement of articles; materials handling conveyors; adjustable height product discharge conveyors; cassette style hopper conveyors; industrial conveyors; machines and apparatus for crushing; grid decks; finger decks; mesh decks; perforated plate decks; wear plates for machines; perforated plates being parts of machines for sorting materials; patented casting plates; wing extension plates; mobile machines adapted to operate by remote control;

In an August 26, 2002 first Office action, the Trademark Examining Attorney contended, in pertinent part, that the mark is merely descriptive of the identified goods and thus is unregistrable under Trademark Act Section 2(e)(1), and that the identification of goods was unacceptable as indefinite. The Trademark Examining Attorney suggested that applicant amend the identification of goods, if accurate, to "electric controllers that monitor and control vibratory screen separators," and that the goods, as amended, be reclassified in International Class 9.

In its February 26, 2003 response to the first Office action, applicant traversed the Section 2(e)(1) refusal, but did not traverse the finding that the identification of goods was unacceptably indefinite. Instead, applicant proposed to amend the identification of goods to include goods in both Class 7 and Class 9, as follows:²

Class 11 - apparatus for lighting and heating; halogen work lights; halogen lamps; installations for lighting incorporating halogen heating devices; and

Class 12 - vehicles; apparatus for locomotion by land, air or water; aerial conveyors; conveyor installations; self-propelled track mounted conveyors; remote controlled vehicles; engines for land vehicles; starting devices for engines of land vehicles.

² Applicant paid the proper fee for the additional class.

Class 7 - machine components for use in a material screening and separating machine, namely, component parts of mobile and non-mobile material separator machines adapted to be monitored or operated by local or remote control, including valves, pumps, sensors, motors, hydraulic parts, drive tracks, track mounts, wheels, wheeled bogies, brakes, screen boxes, shredders, diesel engines, fuel delivery systems, exhaust systems, vibrating grids, chutes, hoppers, ignition parts, casting plates, tipping grids, temperature sensors, propulsion units, conveyors, and bundled or integrated systems of components for use in same; and

Class 9 - electronic technology for remote or local monitor and control of material filter and separator machines; electronic technology for radio or manual control of material screening and separator machines.

In her first final Office action, issued July 8, 2003, the Trademark Examining Attorney made final the mere descriptiveness refusal under Trademark Act Section 2(e)(1), and also made final her requirement for an acceptable identification of goods. Specifically, the Trademark Examining Attorney found many of the terms appearing in applicant's proposed amended identification of goods to be unacceptably indefinite. She then suggested that "[t]he applicant may adopt the following identification of goods in International Class 7, if accurate" (emphasis in original):

Machine components for use in a material screening and separating machines, namely, component parts of mobile and non-mobile material separator

machines adapted to be monitored or operated by local or remote control, **namely**, valves, pumps, sensors, motors, hydraulic parts, **namely**, **[identify each hydraulic part by common commercial name]**, drive tracks, track mounts, wheels, wheeled bogies, brakes, screen boxes, shredders, diesel engines, fuel delivery systems, exhaust systems **consisting primarily of [indicate primary components]**, vibrating grids, chutes, hoppers, ignition parts, **namely**, **[identify each by common commercial name]**, casting plates, tipping grids, propulsion units, **namely**, **[identify by common commercial name]**, conveyors, and bundled or integrated systems of components for use in same **and consisting primarily of [indicate primary components]**.

She also suggested that "[t]he applicant may adopt the following identification of goods in International Class 9, if accurate" (emphasis in original):

Electronic **controls** for remote or local monitor and control of material filter and separator machines; electronic **controls** for radio or manual control of material screening and separator machines; and electronic temperature sensors.

In response to the July 8, 2003 final Office action, applicant, on January 7, 2004, filed a notice of appeal, a request for reconsideration of the final refusal, and a Request to Divide the application.³

³ In the Request to Divide, applicant requested that the mark in the "child" application (which subsequently, upon division, was assigned Serial No. 76976415) be registered on the Supplemental Register (not the Principal Register) for goods identified as:

Class 7 - machine components for use in mobile and non-mobile material separator machines adapted to be

In the "parent" application which eventually resulted from the division of the application (Ser. No. 76400174, involved herein), the Board instituted applicant's appeal and remanded the application to the Trademark Examining Attorney for review of applicant's request for reconsideration of the July 8, 2003 final refusal. In that request for reconsideration, applicant further traversed

monitored or operated by local or remote control, namely, vibrating screens and decks for installation in vibrating screens, namely woven screen mesh decks, finger decks, grid bar decks, perforated plates; and perforated plate decks; and

Class 9 - electronic controls for remote or local monitor and control of material filter and separator machines, sold individually or as bundled or integrated systems, namely, electronic controllers, electronic computer monitors, and computer software embedded or for installation in controllers of screens, namely, ellipse screens, woven screens, finger plates, finger decks, grid decks, mesh decks, perforated plates; perforated plate decks, and wear plates.

After further prosecution of the "child" application (during which the Trademark Examining Attorney maintained her refusal to accept the amended Class 7 identification of goods on the ground that it was beyond the scope of the original identification of goods), the mark eventually was registered on the Supplemental Register (as Registration No. 2974813, issued July 19, 2005) for the following Class 9 goods only:

electronic controls for remote or local monitor and control of material filter and separator machines, sold individually or as bundled or integrated systems, namely, electronic controllers, electronic computer monitors, and computer software that is embedded in or for installation in controllers of screens and controls or monitors components of filtering and separating machines consisting of ellipse screens, woven screens, finger plates, finger decks, grid decks, mesh decks, perforated plates, perforated plate decks, and wear plates.

the mere descriptiveness refusal, and also proposed the following amendment to the identification of goods (taking into account the Trademark Examining Attorney's suggestions and also the removal of various goods to the "child" application):

Class 7 - machine components, sold separately or sold as bundled or integrated systems, for use in mobile and non-mobile material separator machines adapted to be monitored or operated by local or remote control, namely, valves, pumps, sensors, motors, drive tracks, track mounts, wheels, wheeled bogies, brakes, shredders, diesel engines, exhaust systems consisting primarily of manifolds, pipes, mufflers; vibrating grids, chutes, hoppers, ignition parts, namely ignition keys, ignition switches, ignition batteries, and ignition starters; casting plates, tipping grids, non-electronic temperature sensors, propulsion units, namely hydraulic drive motors; and conveyors; and

Class 9 - electronic systems for remote or local monitor and control of material filter and separator machines, sold individually or as bundled or integrated systems, namely, computer monitors, computer key pads, computer displays, computer cursor controllers, electrical controllers, computer software embedded or for installation in an electrical controller; electronic systems for radio or manual control of material screening and separator machines; electronic temperature sensors.

In a March 11, 2004 Office action in response to applicant's request for reconsideration of the July 8, 2003 final refusal, the Trademark Examining Attorney withdrew

the finality of her refusals and requirements in view of the following new "additional issue":

The proposed amendment to the identification cannot be accepted because the goods in International Class 7 refer to goods that are not within the scope of the identification that was set forth in the application at the time of filing [i.e., "components for monitor and control of material screening and separating apparatus"]. Only goods that actually control or monitor would be considered within the scope of the original identification of goods. Goods that are a component part of the material separator machines that do not perform the function of controlling or monitoring are outside the scope of the original identification of goods. While the identification of goods and/or services may be amended to clarify or limit the goods and/or services, additions to the identification or a broadening of the scope of the identification are not permitted. ... Therefore this wording should be deleted from the identification.

The applicant may adopt the following identification of goods, if accurate:

Class 9 - Electronic systems for remote or local monitor and control of material filter and separator machines; sold individually or as bundled or integrated systems, namely, computer monitors, computer key pads, computer displays, computer cursor controllers, electrical controllers, computer software embedded or for installation in an electrical controller that controls or monitors the functions of the various components of filtering and separating machines; electronic systems for radio or manual control of material screening and separator machines consisting primarily of [identify the primary components of the system], and electronic temperature sensors.

In its September 13, 2004 response to this latest Office action, applicant traversed the new identification "issue" raised by the Trademark Examining Attorney, arguing that its proposed amended identification of goods in fact was within the scope of the original identification of goods. Applicant nonetheless proposed the following amendment of the identification of goods:

Class 7 - machine components, sold separately or sold as bundled or integrated systems, for use in mobile and non-mobile material separator machines adapted to be monitored or operated by local or remote control, namely, valves, pumps, sensors, motors, drive tracks, track mounts, wheels, wheeled bogies, brakes, shredders, diesel engines, exhaust systems consisting primarily of manifolds, pipes, mufflers; vibrating grids, chutes, hoppers, ignition parts, namely ignition keys, ignition switches, ignition batteries, and ignition starts; casting plates, tipping grids, non-electronic temperature sensors, propulsion units, namely hydraulic drive motors; and conveyors; and

Class 9 - electronic systems for remote or local monitor and control of material filter and separator machines, sold individually or as bundled or integrated systems, namely, computer monitors; computer key pads; computer displays; computer cursor controllers; electrical controllers; computer software that is embedded in or for installation in an electrical controller that controls or monitors those components of filtering and separating machines consisting of valves, pumps, sensors, motors, drive tracks, track mounts, wheels, wheeled bogies, brakes, shredders, diesel engines, exhaust systems consisting primarily of manifolds, pipes, mufflers; vibrating grids, chutes, hoppers, ignition parts, namely ignition keys, ignition switches, ignition batteries, and ignition

starters, casting plates, tipping grids, non-electronic temperature sensors, propulsion units, namely hydraulic drive motors, and conveyors; electronic temperature sensors.

The Trademark Examining Attorney then issued a new final Office action on October 27, 2004, in which she renewed the final refusal on the ground of mere descriptiveness and rejected applicant's proposed amendment to the identification of goods. Specifically, she found again that all of the Class 7 goods in the proposed amendment were beyond the scope of the original identification of goods, and she found that certain of the Class 9 goods identified in the proposed amendment, i.e., "vibrating grids, chutes, hoppers, ignition parts, namely ignition keys, ignition switches, ignition batteries, and ignition starts, casting plates, tipping grids, non-electronic temperature sensors, propulsion units, namely hydraulic drive motors, and conveyors," were beyond the scope of the original identification of goods. She suggested that applicant adopt the following Class 9 identification of goods, if accurate:

electronic systems for remote or local monitor and control of material filter and separator machines, sold individually or as bundled or integrated systems, namely, computer monitors, computer key pads, computer displays, computer cursor controllers, electrical controllers, and computer

software that is embedded in or for installation in an electrical controller that controls or monitors those components of filtering and separating machines, namely, valves, pumps, sensors, motors, drive tracks, track mounts, wheels, wheeled bogies, brakes, shredders, diesel engines, exhaust systems consisting primarily of manifolds, pipes, mufflers; and electronic temperature sensors.

After issuance of the new final refusal, the application was returned to the Board and the appeal was resumed. Applicant filed its appeal brief on August 15, 2005, identifying, as the issues on appeal, the following: the acceptability of the Class 7 identification of goods; the acceptability of the Class 9 identification of goods; the mere descriptiveness of the mark as applied to the Class 7 goods; and the mere descriptiveness of the mark as applied to the Class 9 goods.

The Trademark Examining Attorney then filed her brief on October 4, 2005. In her brief, the Trademark Examining Attorney maintained her mere descriptiveness refusal as to both classes of goods, as well as her contention that applicant's proposed Class 7 goods and certain of its proposed Class 9 goods are unacceptable because they are beyond the scope of the original identification of goods. However, she also stated that applicant's Class 9

identification of goods would be acceptable if it were amended to read:

electronic systems for remote or local monitor and control of material filter and separator machines, sold individually or as bundled or integrated systems, namely, computer monitors, computer key pads, computer displays, computer cursor controllers, electrical controllers; computer software that is embedded in or for installation in an electrical controller that controls or monitors those components of filtering and separating machines consisting of valves, pumps, sensors, motors, drive tracks, track mounts, wheels, wheeled bogies, brakes, shredders, diesel engines, exhaust systems consisting primarily of manifolds, pipes, mufflers, vibrating grids, chutes, hoppers, ignition parts, namely ignition keys, ignition switches, ignition batteries, and ignition starters, casting plates, tipping grids, non-electronic temperature sensors, propulsion units, namely hydraulic drive motors, and conveyors; electronic temperature sensors.⁴

Applicant filed a reply brief on November 14, 2005, in which it stated that the Class 9 identification of goods suggested by the Trademark Examining Attorney in her brief is "accurate and acceptable." (Applicant noted that if this Class 9 language had been suggested in the Trademark Examining Attorney's October 27, 2004 final Office action,

⁴ That is, the Trademark Examining Attorney contends that the Class 9 identification of goods would be acceptable if applicant were to replace the semi-colon after the word "mufflers" with a comma, which would make the items which follow ("vibrating grids" through "conveyors") part of the "components of filtering and separating machines consisting of...", rather than stand-alone items which are beyond the scope of the original identification of goods.

applicant would have amended the application accordingly in response thereto, prior to resumption of the appeal.)

ANALYSIS

Class 9 Identification of Goods.

In view of the Trademark Examining Attorney's suggestion, in her brief, of an acceptable Class 9 identification of goods, and in view of applicant's stated agreement to such an amendment, the application shall be amended to include the Class 9 identification of goods suggested by the Trademark Examining Attorney and agreed to by applicant. The issue of the acceptability of the Class 9 identification of goods (i.e., whether it is beyond the scope of the original identification of goods) is therefore moot.

Class 7 Identification of Goods.

The acceptability of applicant's proposed Class 7 identification of goods remains to be decided. Trademark Rule 2.71(a), 37 C.F.R. 2.71(a), provides that "[t]he applicant may amend the application to clarify or limit, but not to broaden, the identification of goods and/or services." The issue before us is whether applicant's latest proposed Class 7 identification of goods, i.e.,

machine components, sold separately or sold as bundled or integrated systems, for use in mobile and non-mobile material separator machines adapted to be monitored or operated by local or remote control, namely, valves, pumps, sensors, motors, drive tracks, track mounts, wheels, wheeled bogies, brakes, shredders, diesel engines, exhaust systems consisting primarily of manifolds, pipes, mufflers; vibrating grids, chutes, hoppers, ignition parts, namely ignition keys, ignition switches, ignition batteries, and ignition starts; casting plates, tipping grids, non-electronic temperature sensors, propulsion units, namely hydraulic drive motors; and conveyors

is within the scope of the identification of goods as filed in the original application, i.e., "components for monitor and control of material screening and separating apparatus."

The Trademark Examining Attorney contends that the proposed amendment is an expansion of or addition to the original identification of goods, and that it therefore is impermissible under Trademark Rule 2.71(a). She argues (at unnumbered page 10 of her brief):

The applicant's original identification of goods identified components that "monitor and control." The applicant's current identification of goods in International Class 7 lists goods that are to be monitored or controlled but do not themselves perform any monitoring or controlling functions. Almost any electronic device or piece of machinery is capable of being monitored or remotely controlled. To let the applicant amend the identification to lists [sic - list] goods being controlled rather than goods performing the

controlling and monitoring function is an impermissible amendment to the identification of goods.

She concludes that the Class 7 goods as identified in applicant's proposed amendment must be deleted from the identification of goods.

For its part, applicant argues that the Trademark Examining Attorney, in the paragraph from her brief quoted above, "mis-quotes the identification of goods in applicant's application, converting applicant's 'components *for*' to 'components *that* "monitor and control."' [Emphasis applicant's.] This is an impermissible attempt by the examining attorney to squeeze applicant's as-filed wording into a wording that would support the examiner's argument." (Applicant's Reply Brief at 5.) Applicant also argues as follows (emphasis applicant's):

When submitting its application under § 44, Applicant stated that it intended to use the mark in commerce in connection with "components for monitor and control of material screening and separating apparatus." To the extent that applicant and the examining attorney differ in the interpretation of what was originally intended, the original identification was admittedly ambiguous. Accordingly, at the suggestion and direction of the examining attorney, applicant clarified the identification of goods in international class 7. See, Office Action of July 8, 2003; Request for Reconsideration, January 7, 2004.

Such clarifying amendments are permitted, so long as they do not broaden improperly the scope of the original identification. Here, the original (admittedly ambiguous) identification indicated that the mark related to *components* for monitor and control of a material screening and separating apparatus. The identification was not, as presumed by the examining attorney, limited to those particular components that contain a microprocessor and thus actively perform monitoring or controlling functions. Rather, the identification related to applicant's intent to use the mark in connection with technology involving a variety of components that applicant has referred to on its web site collectively as "SmartScreen technology."

(Applicant's Reply Brief at 2-3.) Applicant further argues:

On page 10, middle paragraph [of the Trademark Examining Attorney's brief, quoted above], the examining attorney objects that

Almost any electronic device or piece of machinery is capable of being monitored or remotely controlled. To let the applicant amend the identification to lists [sic.] goods being controlled rather than goods performing the controlling and monitoring function is an impermissible amendment to the identification of goods.

Applicant responds that, first, it is clear from the suggested class 7 identification made by the examining attorney on July 8, 2003, that the examining attorney at that time considered components capable of being monitored or remotely controlled to be within the original scope of goods. Second, the use of active verbs performing the controlling and monitoring is read into the identification of goods by the examiner. There is no evidence at all that applicant ever intended to

limit its identification to goods doing the controlling, as opposed to being controlled.

There is ample evidence to the contrary, however. Applicant clearly considered its mark SMARTSCREEN to relate to components that were classified in international class 7, as evidenced by the fact that applicant filed its priority application in international class 7 for:

Class 07 - crushing and material filtering machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; components for monitoring and controlling material filtering and separating apparatus; control apparatus and installations for engines, industrial machines, machine tools and motors; conveyors; conveyors for controlling the movement of articles; materials handling conveyors; adjustable height product discharge conveyors; cassette style hopper conveyors; industrial conveyors; machines and apparatus for crushing; grid decks; finger decks; mesh decks; perforated plate decks; wear plates for machines; perforated plates being parts of machines for sorting materials; patented casting plates; wing extension plates; mobile machines adapted to operate by remote control.

GB application no. 2,292,768.

In the paragraph bridging pages 10-11 [of her brief], the examining attorney dismisses applicant's arguments as to the importance of the foreign application. The foreign priority application is an indicia of intent as to the scope of goods intended. The priority application was drafted by a foreign attorney to be appropriate for examination in a foreign jurisdiction. It was not applicant's intent to narrow its scope of protection, but rather to tailor the wording of the identification in [a] way that, at that time, it thought to be appropriate for United States examination. Thus, applicant's reference to the class 7 goods described in GB 2,292,768, is submitted for the purpose of providing an objective, albeit merely persuasive, indication of the intent behind the

ambiguous description [in] applicant's original US application.

Based on the class 7 identification suggested by the examining attorney in her July 8, 2003, office action, it is reasonable to assume that she understood the original identification of goods to encompass at least those goods within class 7.

(Applicant's Reply Brief at 5-6.)

We have considered applicant's arguments, but we are not persuaded. First, we disagree with applicant's contention that the original identification of goods was "ambiguous" on the issue of whether the identified "components for monitor and control of material screening and separating apparatus" should be read to include only components that do the monitoring and controlling, or (as applicant contends) it should also be read to include all of the other components of the apparatus (as listed in the proposed identification of goods) which are monitored and controlled. We find that "components for monitor and control of material screening and separating apparatus" reasonably can be read only to include those components of the apparatus which do the monitoring and controlling. Although "components" is indefinite because it does not specify what the particular items are, "components for monitor and control" is neither indefinite nor ambiguous, in that it clearly limits the nature and purpose of the

"components" to those components which actually perform the monitoring and controlling functions.

Furthermore, we disagree with applicant's contention that its "intent" in drafting its identification of goods for the original application (i.e., that the identified "components" include both components that do the controlling and components that are controlled) is relevant to the issue of whether the Class 7 goods included in its current proposed amended identification of goods are within the scope of the original identification of goods. In resolving this issue, we must look to the terms of the original identification of goods, not to applicant's underlying intent (whether as manifested by applicant's foreign application or otherwise). The purpose of the identification of goods is to give notice to third parties of what applicant's goods are. Such third parties have only the terms of the identification of goods as the basis for making that determination; they are not privy to applicant's "intent," and applicant's intent therefore is irrelevant. As discussed above, we find the original identification of goods to be unambiguous in its coverage of only those components of the apparatus that do the controlling and monitoring. Even assuming that applicant intended for the scope of the coverage to be broader, i.e.,

to also include those components which are controlled and monitored, we cannot read such a broad scope of coverage into the original identification of goods without disregarding its plain language.

Finally, we are not persuaded by applicant's contention that, because the Trademark Examining Attorney herself, earlier in the prosecution of the application, suggested an identification of goods which included components other than those which perform a controlling or monitoring function, we should deem the original identification of goods to be ambiguous and elastic enough to encompass components which perform no controlling or monitoring function. The Trademark Examining Attorney's suggestion obviously was erroneous and inconsistent with the terms of the original identification of goods, a fact which she realized, albeit belatedly, by subsequently rejecting applicant's proposed amendment on the ground that it exceeds the scope of the original identification of goods.

In summary, we find that because the Class 7 goods included in applicant's proposed amended identification of goods are not and cannot fairly be deemed to be "components for monitor and control of material screening and separating apparatus," they are beyond the scope of the

original identification of goods. Applicant's proposed amendment adding these Class 7 goods therefore is prohibited by Trademark Rule 2.71(a), and we can give the proposed amendment no effect. Rather, we deem applicant's original identification of goods, "components for monitor and control of material screening and separating apparatus," to be amended to include only those Class 9 goods which are the subject of the amendment suggested by the Trademark Examining Attorney in her brief and agreed to by applicant in its reply brief, i.e.:

electronic systems for remote or local monitor and control of material filter and separator machines, sold individually or as bundled or integrated systems, namely, computer monitors, computer key pads, computer displays, computer cursor controllers, electrical controllers; computer software that is embedded in or for installation in an electrical controller that controls or monitors those components of filtering and separating machines consisting of valves, pumps, sensors, motors, drive tracks, track mounts, wheels, wheeled bogies, brakes, shredders, diesel engines, exhaust systems consisting primarily of manifolds, pipes, mufflers, vibrating grids, chutes, hoppers, ignition parts, namely ignition keys, ignition switches, ignition batteries, and ignition starters, casting plates, tipping grids, non-electronic temperature sensors, propulsion units, namely hydraulic drive motors, and conveyors; electronic temperature sensors.

Mere Descriptiveness.

We turn now to the remaining issue to be decided in this appeal, i.e., whether applicant's mark SMARTSCREEN is merely descriptive of the above-listed Class 9 goods identified in the application, as amended.

A term is deemed to be merely descriptive of goods or services, within the meaning of Trademark Act Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *See, e.g., In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987), and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. *See In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services, and the possible significance that the term would

have to the average purchaser of the goods or services because of the manner of its use. That a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Moreover, it is settled that "[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them." *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002). See also *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corporation*, 226 USPQ 365 (TTAB 1985).

The evidence of record includes a printout of pages from applicant's website, made of record by the Trademark Examining Attorney with her July 8, 2003 Office action, which provide information regarding applicant's goods. Typical text appearing on this website includes the following:

Metso Minerals launches a new mobile screen, the Nordberg ST351 with revolutionary SmartScreen™ technology, at Intermat 2003 in Paris.

SmartScreen™ refers to an intelligent controller in the Nordberg ST351 that monitors and adjusts

the screen automatically to achieve optimum screening results. The controller maintains maximum screening efficiency by controlling the feed rate and screen performance. It also controls start-up and shut-down processes, while carefully monitoring all the key functions and components of the screen to ensure longevity and reliability.

...

With the Nordberg ST171, Metso Minerals introduces the revolutionary SmartScreen™ technology. The new ST171 is the first really intelligent mobile screen in the market with the ability to monitor its performance and adjust itself continuously for the most effective screening process.

By just pushing one button, the ST171 starts the whole screening process. The new Intelligent Controller IC300 supervises and adjusts the unit automatically for optimum screening results, depending on conditions and materials. In addition, it carefully monitors all the key functions and components of the unit to insure longevity and reliability. Using the interactive display, you can easily converse with the unit and view the complete operation.

We take judicial notice that "screen" is defined, in pertinent part, as follows: "a perforated plate, cylinder, or similar device or a meshed wire or cloth fabric usu. mounted on a frame and used to separate coarser from finer parts or to allow the passage of smaller portions while preventing that of larger." Webster's Third New International Dictionary of the English Language Unabridged

(1993) at p. 2040.⁵ That the "material filter and separator machines" specified in applicant's identification of goods are, in function and in fact, "screens," is clearly shown by applicant's repeated reference to its products as "screens" on its website. See, e.g., "Metso Minerals launches a new mobile screen..."; "The new ST171 is the first really intelligent mobile screen in the market..." We thus find that SCREEN is merely descriptive of applicant's goods; the identified goods are indeed components of applicant's "material filter and separator machines," i.e., screens. That the listed components themselves are technically not "screens" is of no moment; the word SCREEN immediately describes the product or machine of which the listed components are an integral part.

The American Heritage Dictionary of the English Language (3d ed. 1992) defines "smart," in pertinent part, as "of, relating to, or being a highly automated device, especially one that imitates human intelligence." The Board has repeatedly found and held that the word "smart" is merely descriptive of goods which are computer-automated or -controlled. See *In re Finisar Corp.*, 78 USPQ2d 1618

⁵ The Board may take judicial notice of dictionary definitions. See *University of Notre Dame du Lac v. J.C. Gourmet Food Imports*

(TTAB 2006)(SMARTSFP merely descriptive of optical transceivers); *In re Tower Tech Inc., supra* (SMARTTOWER merely descriptive of commercial and industrial cooling towers and accessories therefor, sold as a unit); and *In re Cryomedical Sciences Inc., 32 USPQ2d 1377* (TTAB 1994)(SMARTPROBE merely descriptive of disposable cryosurgical probes).

Applicant's website shows that the term "smart" is merely descriptive of a key feature or characteristic of applicant's goods; it immediately informs purchasers that the identified components allow applicant's "material filter and separator machines" to be "smart," i.e., electronically automated, monitored and controlled by computer. See, e.g., "SmartScreen™ refers to an intelligent controller in the Nordberg ST351 that monitors and adjusts the screen automatically to achieve optimum screening results"; "The new ST171 is the first really intelligent mobile screen in the market with the ability to monitor its performance and adjust itself continuously for the most effective screening process"; "The new Intelligent Controller IC300 supervises and adjusts the unit

Co., 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

automatically for optimum screening results, depending on conditions and materials."

Applicant argues that its website establishes, at best, that only one particular component of applicant's machines, i.e., the "intelligent controller," is controlled by a microprocessor and is therefore "smart." Applicant contends that, as a result of applicant's division of the application (see discussion, *supra*), the goods identified as "electronic controllers" have been removed from the present application and no longer form part of the identification of goods, such that "smart" does not describe any of the identified goods.

We are not persuaded by this argument. The goods identified in the application as "electronic systems for remote or local monitor and control of material filter and separator machines, sold individually or as bundled or integrated systems, namely, computer monitors, computer key pads, computer displays, computer cursor controllers, electrical controllers" are themselves the components that make applicant's screening machines "smart," and SMART merely describes this feature of the goods. Similarly, the goods identified as "computer software that is embedded in or for installation in an electrical controller that controls or monitors" the other components of applicant's

filtering and separating machines are an integral part of what makes applicant's screens "smart." See *In re Tower Tech Inc.*, *supra* (SMARTTOWER merely descriptive even if there are no microprocessors within the shell of the tower).

In addition to finding that both SMART and SCREEN are merely descriptive of applicant's goods, we also find that the composite SMARTSCREEN is merely descriptive of the goods. It is apparent that the two words do not lose their merely descriptive significance by being joined together, nor does the composite itself result in a unique or distinctive meaning which differs from the meanings of the words considered separately. The identified goods are components of a "smart screen," i.e., a screen which is automated and controlled by computer. SMARTSCREEN merely describes this feature of the goods. Cf. *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) (SCREENWIPE generic for "pre-moistened, anti-static cloth for cleaning computer and television screens").

CONCLUSION

In summary, we find that the Class 7 goods contained in applicant's latest proposed amendment to the identification of goods are impermissibly beyond the scope

of the original identification of goods, and that the proposed amendment therefore cannot be entered. The identification of goods in the application is amended, however, to incorporate only the Class 9 goods as suggested in the Trademark Examining Attorney's brief and as accepted by the applicant in its reply brief.

We further find that applicant's mark SMARTSCREEN is merely descriptive of the Class 9 goods identified in the application, as amended.

Decision: The Section 2(e)(1) refusal is affirmed, and the refusal based on the requirement to amend the identification of goods in Class 7 is affirmed.